

REMARKS

Claims 16-18 and 20-26 are pending. Claims 16-18 and 20 have been rejected. Claims 21-26 have been withdrawn from consideration as directed to a non-elected invention. By this amendment, Claim 16 has been amended, Claims 21-23 have been canceled, and Claims 27-31 have been added. Entry of this amendment, rejoinder of Claims 24-26, and reconsideration and allowance of Claims 16-18, 20, and 24-31 is respectfully requested in view of the above amendments and following remarks.

Request for Entry of the Amendment

Applicant respectfully requests that the amendment be entered. Applicant believes that entry of the amendment is proper because the amendment places the application in condition for allowance without raising new issues requiring further search and/or consideration.

The Rejection of Claims 16-18 and 20 Under 35 U.S.C. § 103(a)

Claims 16-18 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,219,453, issued to Sakurai et al, in view of U.S. Patent No. 6,156,845, issued to Saito. Withdrawal of the rejection is respectfully requested for the following reasons.

Claim 16 is an independent claim directed to a composition for the manufacture of paper that includes inorganic mineral powders, polyethylene, and an additive. Claims 17, 18, and 20 depend from Claim 16.

Claim 16 has been amended to recite that the inorganic mineral powders are present in an amount from about 70% to about 80% and that the polyethylene is present in an amount from about 28% to about 18%. These ranges do not overlap with the ranges of materials described in the Sakurai reference. Support for the amendment can be found at page 14, lines 9-14 (Example 2) and page 15, lines 15-20 (Example 4).

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{LLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

The Sakurai reference describes an organic filler-incorporated ethylene polymer film made of an ethylene polymer composition that includes (a) 35%-90% by weight, based on the weight of the ethylene polymer composition, of an ethylene polymer; (b) 10%-65% by weight, based on the weight of the ethylene polymer composition, of a finely divided inorganic filler particle; (c) 0.1 to 10 parts by weight, based on 100 parts by weight of the inorganic filler particle, of a higher fatty acid; (d) 0.5 to 15 parts by weight, based on 100 parts by weight of the inorganic filler particle, of a metal salt of a higher fatty acid; and (e) 0.05 to 5 parts by weight, based on 100 parts by weight of the inorganic filler particle, of a stabilizer composition. According to Col. 3, line 66, to Col. 4, line 2 of the reference, the use of a higher fatty acid, and metal salt of the higher fatty acid, and the specified amounts are required for obtaining optimum films having a high degree of toughness. Furthermore, the amount of ethylene polymer required in the composition described in the reference is so high (i.e., 35%-90% by weight) that making the film results in the production of toxic gas, which is not environmentally friendly. As noted above, Claim 16 has been amended to recite amounts of inorganic mineral powders and polyethylene that are neither taught nor suggested by the Sakurai reference.

The deficiencies of the teaching of the Sakurai reference are not cured by the teaching of the Saito reference. The Saito reference is directed to an olefin (co-)polymer composition comprising 0.01 to 5.0 weight parts of a high molecular weight polyethylene (an ethylene homopolymer or an ethylene- α -olefin copolymer containing 50 weight % or more of ethylene units) and 100 weight parts of a polypropylene (a polypropylene homopolymer or copolymer of propylene with at least one of ethylene or α -olefins). The object of the reference is to provide a polyolefin compound having high melt tension and high crystallization temperature suitable for hollow molding, foam molding, and extrusion molding. The claimed invention is distinct from the Saito reference with regard to the polymer components. The claimed invention recites

polyethylene only, while the cited reference relates to a combination of polyethylene and polypropylene. Papers made from polypropylene have significant drawbacks including bad foldability and no tearing ability, which are undesired for the environmentally friendly paper of the present invention.

Because the cited references, either alone or in combination, fail to teach or suggest every limitation of the claimed invention (the amended ranges for inorganic mineral powders and polyethylene), the invention as now claimed is nonobvious and patentable over the cited references. Withdrawal of the rejection is respectfully requested.

Applicant's comment that the claimed invention does not include either a higher fatty acid or a metal salt of a higher fatty acid as required by the Sakurai reference was directed to the establishment of the Examiner's prima facie case of obviousness. In seeking to establish a prima facie case of obviousness, it is impermissible to pick and choose only so much of a reference as will support the Examiner's position, to the exclusion of other parts necessary to the full appreciation of what the reference fairly teaches or suggests to one of ordinary skill. The Sakuria reference fairly teaches a composition requiring a higher fatty acid and a metal salt of a higher fatty acid. Similarly, the Saito reference fairly teaches a composition requiring polypropylene. The claimed composition includes neither a higher fatty acid, a metal salt of a higher fatty acid, nor polypropylene. The combined teachings of these references taken as a whole do not render obvious the claimed invention.

New Claims 27-31

Claims 27-31 have been added. No new matter has been added. Support for the new claims can be found in the specification as originally filed.

Like Claim 16, Claim 27 is an independent claim directed to a composition for the manufacture of environmentally friendly paper. Claim 27 corresponds to Claim 16, except that

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{LLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

Claim 27 does not recite specific additives. Claims 28-31 depend from Claim 27 are relate to the inorganic mineral powders (see Claim 17), polyethylene (see Claim 18), granule form (see Claim 20), and additives (see Claim 16), respectively.

For the reasons set forth above regarding Claim 16, applicant believes that Claims 27-31 are patentable over the cited references.

Rejoinder of Claims 24-26

Rejoinder of Claims 24-26 is respectfully requested. Claims 21-26 have been withdrawn from consideration as drawn to a non-elected invention. Although the subject matter of Claims 16-18 and 20 and 27-30 relate to a composition for the manufacture of an environmentally friendly paper and the subject matter of Claims 24-26 relates to an environmentally friendly paper, independent Claims 16 (composition for manufacture) and 24 (paper) each recite the same ingredients in the same amounts. Claim 24 has been amended to conform to amended Claim 16.

For the reasons set forth above regarding Claim 16, applicant believes that Claims 24-26 are patentable over the cited references.

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LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

Conclusion

In view of the above amendments and forgoing remarks, applicant believes that Claims 16-18, 20, and 24-31 are in condition for allowance. If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone applicant's attorney at 206.695.1755.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}

George E. Renzoni

George E. Renzoni, Ph.D.
Registration No. 37,919
Direct Dial No. 206.695.1755

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George E. Renzoni

GER:md

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100